

REMARKS

Applicants submit that this Amendment presents claims in better form for consideration on appeal. Moreover, applicants submit that this Amendment responds to at least one argument that was first presented in the Office Action mailed June 3, 2003. Applicants submit that thus there is a good and sufficient reason why this Amendment is necessary, why this Amendment was not earlier presented, and why this Amendment should be admitted now. Furthermore, applicants believe that consideration of this Amendment could lead to favorable action that would remove one or more issues for appeal.

Office Action Rejections Summary

Claims 1-17 have been rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,148,329 of Meyer ("Meyer").

Status of Claims

Claims 1-17 are pending in the application. Claims 1 and 13 have been amended to more properly define existing claim limitations. In particular, the preexisting claim limitations in the preambles of claims 1 and 13 have been moved into the body of the claims. The amended claims are supported by the specification. No claims have been added. No new matter has been added.

Claim Rejections

Claims 1-17 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Meyer. Applicants submit that claims 1-17 are patentable over the cited reference and disagree with the Office Action's assertions. Applicants have argued that Meyer teaches the redelivery of a stored message to a subscriber in a current format. As such Meyer fails to teach or suggest the claim limitation of "repeatedly generating a revised

update message having a next most recent version format based on the update message until a final update message having an upgraded version format is generated,” as recited in the claims.

The Office Actions cites to 6-7, lines 66-6, respectively, of Meyer for support of its assertion that Meyer teaches the above noted claim limitation. However, this cited passage of Meyer only discusses that the worker request identifies messages in the database that are not of the current version. If messages are found, they are converted to directly to the most recent version. There is no updating of messages to upgraded versions by chaining through intermediate versions taught or suggested in Meyer.

The Office Action then states:

Thus, it would have been obvious to a person of ordinary in the art at time the invention was made to modify the teachings of Meyer with repeatedly generating a revised update message having a next most recent version format based on the update message until a final update message having an upgraded version format is generated. This modification would allow the teachings of Meyer to improve the accuracy and the reliability of the method and apparatus for upgrading a database in a redundant environment by release chaining, and provide a method for redelivery of messages having an associated message version number.

(Office Action, 6/3/03, p. 3)

The only reasoning provided by the Office Action as to the purported modification of Meyer is the advantage provided by the Applicants’ own disclosure. The Office Action further states:

Furthermore, the Examiner recognizes that **references cannot be arbitrarily combined** and that there must be some reason why one skilled in the art would be motivated to make the **proposed combination of primary and secondary references**. In re Nomiya USPQ 607 (CCPA 1975). However, there is no requirement that a motivation to make the modification be expressly articulated. **The test for combining references is what the combination of disclosures** taken as a whole would suggest to one ordinary skill in the art. In re McLaughlin, 170USPQ 209 (CCPA 1971). References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures. In re Bozec, 163 USPQ 545 (CCPA) 1969.

(Office Action, 6/3/03, p. 3)(emphasis added)

Applicants' respectfully submit that the Office Action has not made a combination of references. Rather, the Examiner has cited only a single reference: that of Meyer. If the Examiner is relying on facts which are not of record as common knowledge to arrive at applicants' claim limitation noted above, then the **Examiner is respectfully requested to provide evidentiary support of such**. The Examiner's attention is directed to the PTO memorandum on the "Procedures for Relying Facts Which Are Not of Record as Common Knowledge or for Taking Official Notice," dated February 21, 2002. A courtesy copy is being attached herewith.

Absent such submission of evidentiary support, applicants submit that the rejection of claims 1-17 under 35 U.S.C. §103(a) based solely on Meyer does not render the claims unpatentable. In particular, as discussed in applicants' previous response, one of skill in the art would not be motivated to modify Meyer in the manner purported by the Office Action. The object of the teachings in Meyer is to redeliver a stored message to a subscriber in a current format and to do so in a manner that **speeds up the redelivery function**. (Meyer, col. 1, lines 35-40; col. 2, lines 35-47; col. 8, line 62). One of skill in the art, facing the problems confronting the inventor of Meyer, would not be motivated to modify Meyer in the manner purported by the Office Action because the chaining of intermediate versions would **slow down** the redelivery function, **contrary to the teachings of Meyer**. Therefore, applicants respectfully submit that claim 1 is patentable over Meyer.

Moreover, the Examiner's "**Response to Applicant' Remarks**" in the Office Action failed to address applicants' above noted argument as to why one of skill in the art would not be motivated to modify Meyer in the manner purported by the Office Action. Applicants respectfully request the Examiner to address this argument in the next Office Action. Furthermore, if the Examiner is relying on a combination of references or

facts which are common knowledge, then applicants respectfully request that the Examiner provided evidentiary support, as is the Examiner's burden.

In conclusion, applicants respectfully submit that in view of the arguments set forth herein, the applicable rejections have been overcome.

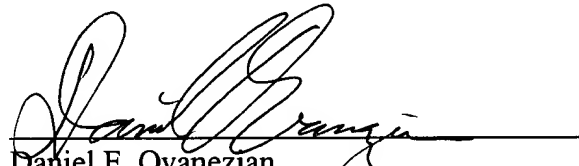
If the Examiner believes a telephone interview would expedite the prosecution of this application, the Examiner is invited to contact Daniel Ovanezian at (408) 720-8300.

If there are any additional charges, please charge our Deposit Account No. 02-2666.

Respectfully submitted,

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